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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,426	12/27/2001	George Brookner	ASCO.P-070	8729

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EXAMINER

WOO, RICHARD SUKYOON

ART UNIT PAPER NUMBER

3629

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PM

Office Action Summary	Application No. 09/683,426	Applicant(s) BROOKNER	
	Examiner Richard Woo	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 and 37-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 and 37-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

- 1) Applicant's amendments filed on October 4, 2004 has been entered.
- 2) Applicant's arguments, filed October 4, 2004, with respect to the prior art rejection have been fully considered and are persuasive. The prior art rejection of previous office action has been withdrawn.

Claim Rejections - 35 USC § 102

- 3) Claims 1-5, 7-14, 16-24, 26-29, and 37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Kara (US 5,717,597).

As for Claim 1, Kara discloses a method for use with mail piece, comprising:
requiring, as a precondition of purchasing at least one postal indicium, receipt of first information about a purchaser's identity (The purchaser of the postage indicium MUST utilize a smart card (186), which is the certificate for identification of purchaser, so as to utilize the franking machine. Accordingly, the purchaser's identity must be required by whoever issues the smart card and this is a precondition of purchasing at least one postal indicium; see col. 5, lines 26-34; and Fig. 1B);

deriving second information from the first information (by reading it from the smart card);

printing the second information upon the at least one postal indicium (see Figs. 16A-B; col. 16, lines 35-60);

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receiving an addressed mail piece with the at least one postal indicium into the mail; and

delivering the mail piece.

As for Claim 2, Kara discloses the method, wherein the postal indicium is an adhesive postage stamp (see Fig. 16A);

As for Claim 3, Kara discloses the method, wherein the postal indicium is a meter strip (see Supra col. 16);

As for Claim 4, Kara discloses the method, wherein the postal indicium is printed on an envelope;

As for Claim 5, Kara further discloses the method, wherein the postal indicium is printed on a post card (see Figs.);

As for Claim 7, Kara discloses the method, wherein the second information is a visibly printed bar code (see supra col. 16);

As for Claim 8, Kara further discloses the method, wherein the second information is a human-readable message (see Id.);

As for Claim 9, Kara discloses the method including number of postal indicia comprising a plurality (see Supra col. 16 for separate indicia), wherein the printing, receiving, and delivering steps are carried out with respect to each of the plurality of indicia.

As for Claim 10, Kara discloses a method for use with mail piece, comprising:

requiring, as a precondition of receiving at least one postal indicium, receipt of first information about a purchaser's identity (The purchaser of the postage indicium MUST utilize a smart card (186), which is the certificate for identification of purchaser, so as to utilize the franking machine. Accordingly, the purchaser's identity must be required by whoever issues the smart card and this is a precondition of purchasing at least one postal indicium; see col. 5, lines 26-34; and Fig. 1B), the postal indicium bear second information derived by electronic computation from first information indicative of the identity of the purchaser (see col. 16, lines 35-60);

receiving an addressed mail piece with the at least one postal indicium into the mail; and

delivering the mail piece.

As for Claim 11, Kara discloses the method, wherein the postal indicium is an adhesive postage stamp (see Fig. 16A);

As for Claim 12, Kara further discloses the method, wherein the indicium is a meter strip (see Supra col. 16);

As for Claim 13, Kara discloses the method, wherein the postal indicium is printed on an envelope;

As for Claim 14, Kara discloses the method, wherein the indicium is printed on a post card (see Figs.);

As for Claim 16, Kara discloses the method, wherein the second information is a visibly printed bar code (see Figs. 16 A-B);

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As for Claim 17, Kara further discloses the method, wherein the second information is a human-readable message (see Figs. 16 A-B for the readable message adjacent the indicia);

As for Claim 18, Kara discloses the method including number of postal indicia comprising a plurality (see Supra col. 16 for separate indicia), wherein the printing, receiving, and delivering steps are carried out with respect to each of the plurality of indicia; and

As for Claim 19, Kara discloses the method wherein the information about the identity is cryptographically signed and inherently the postal service checks any cryptographically signed information (see Supra col. 5).

As for Claim 20, Kara discloses a method for use with mail piece, comprising:
requiring, as a precondition of delivering at least one postal indicium, receipt of first information about a purchaser's identity, the postal indicium bearing second information derived by electronic computation from first information (The purchaser of the postage indicium MUST utilize a smart card (186), which is the certificate for identification of purchaser, so as to utilize the franking machine. Accordingly, the purchaser's identity must be required by whoever issues the smart card and this is a precondition of purchasing at least one postal indicium; see col. 5, lines 26-34; and Fig. 1B) (see col. 16, lines 35-60);

receiving an addressed mail piece with the at least one postal indicium into the mail; and

delivering the mail piece.

As for Claim 21, Kara discloses the method, wherein the postal indicium is an adhesive postage stamp (see Fig. 16A);

As for Claim 22, Kara further discloses the method, wherein the indicium is a meter strip (see Supra col. 16);

As for Claim 23, Kara discloses the method, wherein the postal indicium is printed on an envelope;

As for Claim 24, Kara further discloses the method, wherein the indicium is printed on a post card (see Figs.);

As for Claim 26, Kara discloses the method, wherein the second information is a visibly printed bar code (see Figs. 16 A-B);

As for Claim 27, Kara further discloses the method, wherein the second information is a human-readable message (see Id.);

As for Claim 28, Kara discloses the method including number of postal indicia comprising a plurality (see Supra col. 16 for separate indicia), wherein the printing, receiving, and delivering steps are carried out with respect to each of the plurality of indicia; and

As for Claim 29, Kara discloses the method wherein the information about the identity is cryptographically signed and inherently the postal service checks any cryptographically signed information (see Supra cols. 5 and 16).

As for Claim 37, Kara discloses an indicium including:

information indicative of a postage amount printed by a first process (see Figs. 16 A-b; col. 16, lines 35-60 for separate indicia);

information indicative of a country printed by the first process (inherently, the system will print the country in section in Figs. 16 A-B if the mailing information should include the specific country);

cryptographically signed information indicative of an identity of a purchaser of the adhesive postal indicium (see Supra col. 16);

the cryptographically signed information printed by a different process than the first process (see Id.).

As for Claim 38, Kara discloses a indicia including:

information indicative of a postage amount printed by a first process (see Figs. 16 A-B; col. 16, lines 35-60);

information indicative of a country printed by the first process (inherently, the system will print the country in section in Fig. 1 if the mailing information should include the specific country);

cryptographically signed information indicative of an identity of a purchaser of the adhesive postal indicium (see Supra col. 16); and

the cryptographically signed information printed by a different process than the first process (see Id.).

As for Claim 39, Kara discloses an apparatus comprising:

a plurality of adhesive indicia including information indicative of a postage amount (see Figs. 16 A-B); and information indicative of a country (inherently, the system will print the country in section in Fig. 1 if the mailing information should include the specific country); and

a printer printing cryptographically signed information indicative of an identity of a purchaser (see Figs. 16 A-B and col. 16, lines 35-60).

As for Claim 40, Kara discloses a method comprising:

receiving information indicative of an identity of a purchaser of the adhesive postal indicia (The purchaser of the postage indicium MUST utilize a smart card (186), which is the certificate for identification of purchaser, so as to utilize the franking machine. Accordingly, the purchaser's identity must be required by whoever issues the smart card and this is a precondition of purchasing at least one postal indicium; see col. 5, lines 26-34; and Fig. 1B) (see col. 16, lines 35-60);

cryptographically signing the information indicative of the identity of the purchaser of the adhesive postal indicia (see Supra col. 16); and

printing upon the adhesive postal indicia, information indicative of the cryptographically signed information (see Id.).

4) Claims 30-31 and 41-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruat (WO 95/20200).

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As for Claim 30, Ruat discloses a method for use with mail piece, comprising:
receiving an addressed mail piece with the at least one postal indicium into the mail, the postal indicium bearing information indicative of the identity of the sender (see page 10);

reading the information indicative of the identity of the sender; and

determining whether the sender whose identity is indicated by the information is on the list of expected senders (e.g. see the last paragraph of page 10 for the purpose of sorting or recording the mail).

As for Claim 31, Ruat discloses the method wherein the information about the identity is cryptographically signed and inherently the postal service checks any cryptographically signed information (see the 2nd, 3rd, paragraphs in page 10).

As for Claim 41, Ruat discloses a method comprising:

receiving a delivered mail piece bearing a postal indicium, the postal indicium bearing second information derived by electronic computation from first information indicative of the identity of the sender (see page 10);

reading, by the recipient, the second information (see Id.); and

determining, by the recipient, whether the sender whose identity is indicated by the second information is on the list of expected sender (see the last paragraph in page 10 for the purpose of sorting or recording the mail).

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As for Claim 42, Ruat further discloses the method, wherein the information indicative of identity that is borne in the postal indicium is cryptographically signed, and the reading step further checks the signature (see the 2nd, 3rd, paragraphs in page 10).

Claim Rejections - 35 USC § 103

5) Claims 6, 15, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara in view of Windel et al. (US 5,953,426).

Kara discloses the method as recited earlier, but does not expressly disclose the method including the limitations in Claims 6, 15, and 25.

Windel et al. is cited to show a method for use with mail piece, comprising wherein the second information is an invisibly printed bar code (as requested by USPS; see col. 46).

Since Kara and Windel et al. are both from the same field of endeavor, the purpose disclosed by Windel et al. would have been well recognized in the pertinent art of Kara.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to print an invisible bar code or human readable message, as taught by Windel et al., for the purpose of complying with the postal service's proposals (in col. 46).

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6) Claims 32 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruat in view of Windel et al..

Ruat discloses the method as recited earlier, but does not expressly disclose the method including the limitations in Claims 32 and 43.

Windel et al. is cited to show a method for use with mail piece, comprising inspecting the delivered mail piece when the sender is not on the list of expected senders (by opening the mail piece when the sender is not matched with the database; see the summary of the invention for example).

Since Ruat and Windel et al. are both from the same field of endeavor, the purpose disclosed by Windel et al. would have been well recognized in the pertinent art of Ruat.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to inspect the delivered mail piece when the sender is not on the list of expected senders, as taught by Windel et al., for the purpose of identifying the true sender by opening the mailing piece when a manipulation is found (see col. 7, lines 32-46).

Conclusion

7) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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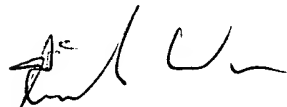
US 5,586,036 is cited to show a method and system for processing mail including imprinting on a mailpiece mailer identification information. Data is encrypted related to the mailpiece with a private key associated with the mailer identification information.

US 5,774,554 is cited to show methods of verifying use of postage charges in respect of mail items. An authentication code is derived from a secret identification of a sender and a part of the destination address of the item.

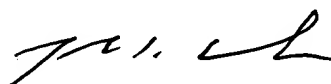
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Woo
Patent Examiner
Art Unit 3629
January 8, 2005



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